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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,083	11/17/2003	Sidney Diamond	57535.010021	3290
<div>7590      02/09/2007 John S. Pacocha GREENBERG TRAURIG, P.C. Suite 2500 77 West Wacker Drive Chicago, IL 60601-1732</div>			<div>EXAMINER STULII, VERA</div> <div>ART UNIT      PAPER NUMBER 1761</div>	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/09/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/715,083

**Applicant(s)**

DIAMOND ET AL.

**Examiner**

Vera Stulii

**Art Unit**

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 and 4-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang et al (5,345,652) in view of Sanchez (5,951,184), Stewart (2,882,170), Silverstein et al (6,136,352), and Clementson (2,953,142).**

In regard to claims 1 and 17, Chuang et al disclose a device comprising a hollow casing having an upper end and a lower end, an opening in the upper end, an opening in the lower end, a plurality of separable refill members carried stacked in the casing, each of the refill members including a base, that is not consumable, the base having an outer periphery passing through the opening of the lower end, and into the hollow casing, the base having an upper section and a lower section, the refill member having an outer periphery and passing through the opening in the lower end, the hollow casing

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and the opening of in the upper end (Abstract, Fig.1, 2, 3, Col.3, 4). In regard to claims 4-6 and 18-20, Chuang et al disclose that refill member is provided with a center cavity (Col. 3 lines 39-40). In regard to claims 7, 8, 9, Chuang et al disclose the device including a removable cap that fits over the upper end of the casing and covers any exposed portion of a refill member, the cap are configured to be frictionally engaged about the upper end of the casing, the cap is made of a transparent synthetic resin material (Col. 4 lines 46-68). In regard to claim 10, Chuang et al disclose that the casing is made of a transparent synthetic resin material (Col. 4 lines 17-19). In regard to claim 11, Chuang et al disclose a tapered portion of the refill member (Col. 3 lines 41-42). In regard to claims 12, 13 and 21, Chuang et al disclose that the lower section of the base has a bottom, the base has a cavity that extends upwardly from the bottom of the lower section of the base, and at least a portion of the refill member of another refill member is nestable in the cavity, refill members are nestable, and frictionally engage each other, to form a connected stack of refill members (Col. 4 lines 27-45). In regard to claims 15 and 16, Chuang et al disclose the device in which the opening in the lower end and the opening in the upper end are circular, and their size is the same (Fig. 1, 2, 3).

Chuang et al do not disclose candy modules, the base not fitting entirely into a standard choke gauge, the base including a post for anchoring the consumable candy piece, the upper section of the base tapers upwardly to a smaller size, at least one rib extending into the opening of the casing.

Sanchez discloses a "candy attachment for a writing instrument for allowing a user to removably mount candy to an end of a writing instrument" (Abstract). Sanchez

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discloses that "device includes an edible candy member having a cylindrical lower end which is frictionally inserted into the cylindrical upper hollow interior of a connector sleeve" (Abstract). Sanchez discloses "the connector sleeve upper section 23 and its upper hollow interior is elongated to permit storing of small candies 14 within it" (Col. 4 lines 11-14). Sanchez discloses "a lid member 16. Its lower end 17 is designed so that it is removably insert able through the connector sleeve member upper end 24 to close the connector sleeve upper section hollow interior 25 so that the candies 14 stored within upper hollow interior 25 do not accidentally fall out. Optionally, the lid member includes an eraser 18 on its upper end. The upper end may also be fashioned into any desired decorative shape" (Col. 4 lines 16-23). Sanchez discloses that "in use, the connector sleeve 20 allows attachment of a candy source 12,14 to the end of a writing instrument 3 to facilitate the eating of the candy while holding the writing instrument 1. The connector sleeve 20 of the candy attachment 10 also allows the candy 12,14 to be removed from the writing instrument 1 without unnecessary direct contact and handling of the candy 12,14 (Col. 4 lines 23-30).

Since Chuang et al disclose a plurality of refill members stacked on the hollow casing, and Sanchez discloses dispensing candy pieces stacked in the hollow casing with optional eraser included, it would have been obvious to one of ordinary skill in the art to employ structure disclosed by Chuang et al and substitute refill members with candy pieces as taught by Sanchez. Since Chuang et al disclose a plurality of refill members, it would have been obvious to one of ordinary skill in the art to adjust the size of the base for security concerns, so the base would not fit entirely into a standard

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choke gauge. Since Chuang et al disclose that refill member is provided with a center cavity, it would have been obvious to one of ordinary skill in the art to insert the post of desired configuration into a cavity in the candy in order to secure the candy mounted on the base. Since Chuang et al disclose a tapered portion of the refill member, it would have been obvious to one of ordinary skill in the art to modify the shape of the base to accommodate candy piece. Since Chuang et al disclose a device comprising a hollow casing having an upper end and a lower end, an opening in the upper end, an opening in the lower end, a plurality of separable refill members carried stacked in the casing, it would have been obvious to one of ordinary skill in the art to employ at least one rib extending into the opening of the casing in order to secure the candy modules inside the hollow casing.

In conclusion, claim 1 differs from disclosure of Chuang et al in the particular product. Claim 1 recites candy, and Chuang et al discloses erasers. Disclosure of Chuang et al is not seen to be limited to erasers. Rather Chuang et al is seen to be a general teaching that any solid article could be stacked in a casing for dispensing purposes. It would have been obvious to substitute one conventional material to be dispensed for another conventional material to be dispensed especially in view of Sanchez and Stewart, who teach the stacking of candy in a cylinder to be dispensed. See also Silverstein et al who discloses it was also conventional to associate candy with a base/support. See also Clementson, who although not disclosing a true other cylindrical sleeve nevertheless further evidences the products associated with bases.

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**Claims 1 and 4-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez (5,951,184) in view of Chuang et al (5,345,652), Stewart (2,882,170), Silverstein et al (6,136,352), and Clementson (2,953,142).**

Sanchez, Chuang et al, Stewart, Silverstein et al and Clementson are taken as cited above.

In regard to using Sanchez as a primary reference, Sanchez discloses candy stacked in a cylinder. Claim 1 differs from Sanchez in the recitation of that the candy is the part of a candy module as therein the candy is associated with a base. As evidenced by Chuang et al and as further evidenced by Silverstein, not only is it conventional to provide dispensable articles dispensed from a cylinder with a support module, it is also conventional to provide candy in a candy module with a support. To modify Sanchez and provide the candy with a conventional support for its art recognized and applicants intended function of the supporting the candy would therefore have been obvious.

### ***Response to Arguments***

Applicant's arguments, see p.8 § 1, filed on November 6, 2006, with respect to the drawings have been fully considered and are persuasive. The objection of the drawings has been withdrawn.

Applicant's arguments, see pp.8-9, filed on November 6, 2006, with respect to claims 1-16 have been fully considered and are persuasive. The rejection of claims 1-16 under 35U.S.C. § 112 has been withdrawn.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Stulii whose telephone number is (571) 272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VS V. Stulii

Steve Weinstein  
STEVE WEINSTEIN  
PRIMARY EXAMINER 1761  
2/9/07